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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/598,637 06/21/00 DE LA POTERIE

V 05725.0598-0

EXAMINER

HM22/0814

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MCDUFFENEY, P

ART UNIT

PAPER NUMBER

1615

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08/14/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/598,637

Applicant(s)  
DE LA POTERIE ET AL

Examiner  
MCQUEENEY

Art Unit  
1615



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other:

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-31 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 5,945,095 to Mougín *et al.*.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Mougín *et al.* disclose a cosmetic composition comprising a non-aqueous dispersion of surface stabilized polymer particles in at least one liquid fatty substance, wherein said particles are particles of at least one polymer, and wherein said polymer particles are stabilized by at least one surface stabilizing polymer (column 14, claim 1). Mougín *et al.* also teach that the liquid fatty substance be an oil from mineral, animal,

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plant, or synthetic origin, or a silicone oil, a hydrocarbon oil, or a fluoro oil (column 14, claim 6). Mougin *et al.* additionally teach that the at least one liquid fatty substance can be chosen from a large number of substances, including liquid paraffin, almond oil, liquid petroleum, sesame oil, corn oil, fatty esters, higher fatty acids, higher fatty alcohols, silicone oils, and many others (column 15, claim 17). Mougin *et al.* teaches examples of fatty esters (column 15, claim 8), fatty alcohols (column 15, claim 10), silicone oils (column 15, claim 11-13), volatile oils (column 15, claim 14), isoalkane (column 15, claim 16). Lastly, Mougin *et al.* teach that their composition can be used for application to the eyelashes (column 16, claim 30).

Claims 1-13, 18, and 21-31 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/42298 to Curtis *et al.*. Curtis *et al.* disclose a wear resistant cosmetic composition which includes a styrene-ethylene/propylene mixed block copolymer in a cosmetically acceptable carrier. Curtis *et al.* teach that their invention can be used in lipsticks, foundations, eye shadows, blushes, or mascaras. Curtis *et al.* found surprising results using the mixed block copolymer as it provides superior wear resistance, and a non tacky, pleasant feel, as well as enhanced wear and longevity (page 2, lines 20-35). Curtis *et al.* further teach that the mixed block copolymer can include an acrylate copolymer as a primary ingredient, or in combination with the mixed block copolymer. Curtis *et al.* further teach that the composition can include other ingredient, such as volatile solvents, wax, powder, non-volatile oils, or emulsifiers (page 6, lines 15-17). Curtis *et al.* teach that the volatile solvent acts as a carrier for the other

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components, rapidly and evenly dispersing them. Examples of the volatile solvent include hydrocarbons, isoparaffins, isododecane, and cyclomethicone (page 6, lines 18-26). Curtis *et al.* further teach that the mixed block copolymer be present in an amount from about 0.01 to about 85 percent by weight (page 5, lines 1-3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Curtis *et al.*, as discussed above, and in view of the following comments. Curtis *et al.* is discussed above as teaching a cosmetic composition, which can be a mascara, and comprises a mixed-block copolymer, an additional acrylate polymer, and a carrier such as a hydrocarbon. Curtis *et al.* do not disclose all of applicant's specific examples for the carrier, or oil substance. However, it is the position of the examiner that the specific carrier chosen is a limitation which would be routinely determined by one of ordinary skill in the art, through minimal experimentation, absent the evidence of unusual and/or unexpected results. The results must be those that accrue from the specific limitations. Furthermore, it is the position of the examiner that Curtis *et al.* teach the essence of applicant's instant claimed invention, which is that the addition of the mixed block copolymer adds wear resistance and longevity to the cosmetic composition. One of

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ordinary skill in the art would have been motivated to create a mascara composition comprising the mixed block copolymer and an additional polymer dispersed in a well known cosmetically acceptable carrier. The expected result would be a composition with all the benefits disclosed by Curtis *et al.*, such as better feel and longevity.

Therefore, this invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. E. McQueeney whose telephone number is 703-306-5827. The examiner can normally be reached on M, T, H, F 7:45 AM to 6:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3592 for regular communications and 703-308-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

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